

Remarks

In the July 30, 2002, Office Action, the Examiner rejected claims 1-33 and 43-53 and objected to claims 34-41 and 42/37. Applicants note that while the Office Action Summary indicates rejection of claim 43, the Detailed Action does not mention claim 43. Applicants interpret the Office Action as only objecting to claim 43 as it depends from claim 42/37, and do not know whether claim 43/42/28 has been rejected.

More specifically, the Examiner rejected claims 1-9, 11-13, 16, 20, 24-30, 45, 46, 48, 49, 50 and 53 under 35 U.S.C. §102(b) as being anticipated by USP 4,416,633 to Laurash, and rejected claims 10, 14-19, 21-23, 31-33, 42/28, 44, 47, 51 and 52 under 35 U.S.C. §103(a) as being unpatentable over Laurash.

Applicants believe that the claims as amended are allowable over the cited prior art and request that the Examiner allow the application to issue.

Independent claim 1 has been amended to recite a certified mailer comprising a first portion comprising a return receipt card and a second portion comprising a recipient address label, an area where the recipient's address is to be located. Claim 28, now cast in independent form, recites a certified mailer in which the recited detachable form forms a detachable return receipt upon folding the second surfaces of each portion to face each other. Independent method claim 45, a method of preparing a package for certified delivery, recites a single sheet comprising a return receipt card and a recipient address label.

None of these claims, nor their dependant claims are anticipated or rendered obvious by Laurash. Laurash does not teach, disclose or suggest a certified mailer, a first portion comprising a detachable return receipt card, a second portion comprising a recipient address label, or a first portion that is folded to form a return receipt card.

In relying on Laurash under §103(a), the Examiner asserted that only the specific arrangement and/or content of indicia as set forth in the claims was missing from Laurash, and asserted that the indicia was not functionally related to the substrate, relying on *In re Gulack*. As noted above, the amended claims recite specific structure which is not present in Laurash. Additionally, Applicants assert that the indicia renders functionality to the mailer: The indicia is not a convenience as asserted by the Examiner.

As stated in *In re Gulack*, “[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter” *In re Gulack*, 217 USPQ 401, 403. While the differences between the claims and Laurash do not reside only in the content of indicia, the indicia must be considered. As the Federal Circuit indicated, “printed matter may well constitute structural limitations upon which patentability can be predicated”. *Id*, footnote. 8.

New claims 53-63 are characterized as re-presented claims, corresponding to original claims 34-41, 42/37 and 43, which were indicated as allowable. Applicants note that claims 54, 58 and 62 are not identical to the indicated corresponding claims. Applicants believes that these claims remain allowable with the changes.

Applicants respectfully request that upon receipt of this response, the Examiner contact the undersigned to discuss these amendments and any issues which the Examiner may believe remain.

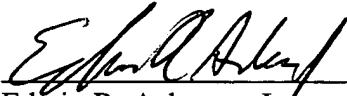
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Respectfully submitted,

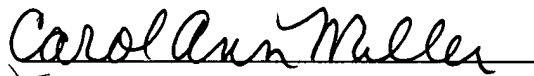
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box Non-Fee Amendment, The Assistant Commissioner for Patents, Washington, D.C., 20231, this 10th day of July, 2003.



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